

**Application number:** 09/923,311

**Art Unit:** 3624

**Applicant:** Khai Hee Kwan

**Examiner:** Alain L Bashore.

**Title:** A computer network method for conducting payment over a network by debiting and crediting utilities accounts

Remark to Action Letter mailed July 28, 2004.

Summary.

In reply to Office Action mailed on July 28, 2004, we respectfully ask the examiner to consider our response below.

We respectfully traverse the examiner's assertion that claims 1-16 are obvious under 103(a) in view of Morrill, Jr (US 5991749 filed 9 Sept 1997) and in view of Mousseau et al ( US Application 2002/0120696 A1 filed 6 April 2001) and that claim 17 is obvious in view of the above and further Resnick (US 6,185,545 B1 filed 17 Nov 1999)

Our main rebuttal is that none of the prior arts suggest the application of utilities accounts for payment transfer. The question is why would Morrill suggest reaching/using the Internet as per our claim when its mobile service provider's link is already linked to the mobile phone device ? The examiner provided no evidence to show how Morrill would inherently show using utilities account (other than mobile phone account which in our amendment has excluded). Furthermore, our claimed invention, our payment initialization is via the Internet and NOT via a wireless network such as mobile phone network or PSTN because our utilities accounts are not mobile phones accounts and hence without the advantage of the direct link to mobile provider system. For example gas utilities account by itself could not be connected to a mobile device since they uses different elements.

Our claimed invention uses utility accounts ( now amended to exclude mobile phone accounts) as the means for payment over the net. Even if mobile phone account could inherent be found in utilities accounts (we submit that this is not and nothing has been stated by the examiner to reveal this), Morrill's invention still would not obvious for initiating a payment transaction over the internet (first network) and/or using a mobile

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device over PSTN ( second network) to confirm and verifying said transaction between two utilities accounts. The claim must be viewed as a whole. Gen. Foods Corp. v. Studiengesellschaft Kohl mbH, 972 F.2d 1272, 1274, 23 USPQ2d 1839, 1840 (Fed. Cir. 1992) ("each claim is an entity that must be considered as a whole"). Morrill's invention is for the use of a mobile device for initiating payment instructions to a mobile service provider between mobile accounts holders over a telecommunication network. The most persuasive evidence could be found at Col 6 lines 39 to 45 where Morrill describes linking computers and herein restated " The computers must be connected to a phone line or must be equipped with an RF antenna and receiver, so that they can receive information from the mobile phone service provider's CPU either by land line connection or wireless transmission. " Also see Col 7 lines 33-34. It is clear this refers to a PSTN and not to the Internet as the first point to reach a service provider's server.

Dependent Claims includes all of the limitations of the independent claim 1. Neither of these references includes any suggestion to combine its features with the features of the other reference. According, applicant respectfully submits that the claims as previously presented and currently amended are also patentable over Morrill, in view of Mousseau and Resnick.

We reiterated the definition of utilities in this application to gas, electricity, water and communication data accounts. We have reproduced our definition at page 2 of our application : "Utility is defined such as gas, water, electricity or communication data that are essential to most modern home or premises." Also at page 4 under Summary "And in both cases they are merely book entries into the accounts with the utility providers such as gas, water, communication or electricity". There is no evidence to show data communication channel accounts must necessarily reveal a mobile telephone voice

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Morrill teaches mobile telephony system to function as an electronic wallet etc to enable payment facilitation using telco accounts ( Col 4 ln 1-39) but NOT utilities accounts as defined above. There is no explanation as to how a mobile phone account could inherently be a gas, electricity, water or data communication accounts nor is it known in the art that there are significant characteristics or interconnectivity in the technology or process amongst them. For example, it is doubtful whether gas can travel via an electricity line. Further, mobile phone account uses air-time as a measurement (10 mins) while in electricity account, it use kWh as unit of measurement or in Data Account (Mega-Bytes downloaded). This means an article for sale or amount to be transferred could be quoted to measure say 300 MB or 400 kWh (as per Utility Units in our specification and claim 2). Morrill made no teaching that his invention could use air-time as a proxy for monetary unit nor could 10 mins show 10 kWh to one ordinary skilled in the art. An inherent disclosure, to be invalidating as an "anticipation," is a disclosure that is necessarily contained in the prior art, and would be so recognized by a person of ordinary skill in that art. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). "Inherency" charges the inventor with knowledge that would be known to the art, although not described. Inherency is not

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We respectfully submit that the prior art would not necessarily work with an utility account given the incompatibility between the needs of a mobile phone account using air

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